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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/290,027	04/09/1999	JOHN W. NOTZ	16356.431	9377

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HAYNES AND BOONE, LLP  
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DALLAS, TX 75202

EXAMINER

KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/290,027

Applicant(s)

NOTZ ET AL.

Examiner

Hani Kazimi

Art Unit

3624

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6,8-10,12,13,15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8-10,12,13,15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

1. This communication is in response to the amendment filed on September 5, 2003.

### ***Status of Claims***

2. Of the original claims 1-18, claims 2, 5, 7, 11, 14, and 16 have been canceled, and claims 1, 4, 8, 10, 13, and 17 have been amended in the amendment filed on March 21, 2002. In the amendment filed on September 16, 2002, claims 1, and 10 have been amended. In the amendment filed on March 19, 2003, claims 1, and 10 have been amended. In the amendment filed on September 5, 2003, claims 1, and 10 have been amended, and claims 19, and 20 have been added. Therefore, claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-20 are under prosecution in this application.

### ***Summary of Office Action***

3. Applicants' arguments filed on September 5, 2003 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 102 are not deemed to be persuasive. Therefore, claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-20 are rejected as being unpatentable over the art cited below, and Applicant's request for allowance is respectfully denied.

***Response to Applicants' Amendment***

4. Applicant's amendment filed on September 5, 2003 is improper. In particular, the added claims 19, and 20 are claimed limitations that were submitted as limitations in claims 1, and 10 in the amendment filed on March 19, 2003. However, in the amendment filed on September 5, 2003, claims 1, and 10 have been amended without showing that these limitations have been deleted from independent claims 1, and 10. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>9</sup> of this title before the invention thereof by the applicant for patent.

6. Claims 1, 3, 4, 6, 8-10, 12, 13, 15, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson et al. US Pat. No. 6,167,383 as discussed in paragraph 5 of paper No. 19.

Further:

Henson teaches that the upsell advisor directly updates the customer configured computer system configuration per the upsell recommendation (column 6, lines 17-30, and column 9, line 40 thru column 10, line 18).

Claims 19, and 20 are rejected as discussed in paragraph 5 of paper No. 19 (see the rejection of claims 1, and 10), since the claimed limitations of claims 19, and 20 were just deleted from claims 1, and 10 and added as dependent claims 19, and 20.

***Response to Arguments***

7. Applicant's arguments have been fully considered. The response to Applicant's arguments with respect to claims 1, and 10 is mentioned above within the 35 U.S.C. 102 rejections of this office action.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

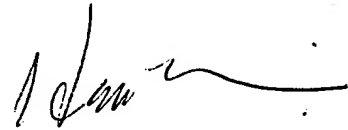
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

Art Unit: 3624

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**

Hani.Kazimi

Art Unit 3624

November 17, 2003